

# PATENT COOPERATION TREATY

From the  
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

## PCT

To:

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NOTIFICATION OF TRANSMITTAL OF  
THE INTERNATIONAL PRELIMINARY  
EXAMINATION REPORT  
(PCT Rule 71.1)

<input type="checkbox"/> <b>TO BE REVIEWED BY ATTORNEY</b>		Date of mailing (day/month/year)	06.07.2004
Applicant's or agent's file reference BA9302PCT		<b>IMPORTANT NOTIFICATION</b>	
International application No. PCT/US 03/13371	International filing date (day/month/year) 30.04.2003	Priority date (day/month/year) 03.05.2002	
Applicant E.I. DU PONT DE NEMOURS AND COMPANY			

- The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary examination report and its annexes, if any, established on the international application.
- A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.

- Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.

#### 4. REMINDER

The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices) (Article 39(1)) (see also the reminder sent by the International Bureau with Form PCT/IB/301).

Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary examination report. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.

For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the PCT Applicant's Guide.

The applicant's attention is drawn to Article 33(5), which provides that the criteria of novelty, inventive step and industrial applicability described in Article 33(2) to (4) merely serve the purposes of international preliminary examination and that "any Contracting State may apply additional or different criteria for the purposes of deciding whether, in that State, the claimed inventions is patentable or not" (see also Article 27(5)). Such additional criteria may relate, for example, to exemptions from patentability, requirements for enabling disclosure, clarity and support for the claims.

**EEL NOTED**

03 Nov 2004

Name and mailing address of the international preliminary examining authority:



European Patent Office - Gitschiner Str. 103  
D-10958 Berlin  
Tel. +49 30 25901 - 0  
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Authorized Officer

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**PATENT COOPERATION TREATY**  
**PCT**  
**INTERNATIONAL PRELIMINARY EXAMINATION REPORT**  
(PCT Article 36 and Rule 70)

Applicant's or agent's file reference <b>BA9302PCT</b>	<b>FOR FURTHER ACTION</b> See Notification of Transmittal of International Preliminary Examination Report (Form PCT/PEA/416)																									
International application No. <b>PCT/US 03/13371</b>	International filing date ( <i>day/month/year</i> ) <b>30.04.2003</b>	Priority date ( <i>day/month/year</i> ) <b>03.05.2002</b>																								
International Patent Classification (IPC) or both national classification and IPC <b>C07C257/10</b>																										
Applicant <b>E.I. DU PONT DE NEMOURS AND COMPANY</b>																										
<p>1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of 5 sheets, including this cover sheet.</p> <p><input type="checkbox"/> This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).</p> <p>These annexes consist of a total of — sheets.</p>																										
<p>3. This report contains indications relating to the following items:</p> <table style="width: 100%;"><tr><td style="width: 5%;">I</td><td style="width: 5%;"><input checked="" type="checkbox"/></td><td style="width: 90%;">Basis of the opinion</td></tr><tr><td>II</td><td><input type="checkbox"/></td><td>Priority</td></tr><tr><td>III</td><td><input checked="" type="checkbox"/></td><td>Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</td></tr><tr><td>IV</td><td><input type="checkbox"/></td><td>Lack of unity of invention</td></tr><tr><td>V</td><td><input checked="" type="checkbox"/></td><td>Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</td></tr><tr><td>VI</td><td><input type="checkbox"/></td><td>Certain documents cited</td></tr><tr><td>VII</td><td><input type="checkbox"/></td><td>Certain defects in the international application</td></tr><tr><td>VIII</td><td><input type="checkbox"/></td><td>Certain observations on the international application</td></tr></table>			I	<input checked="" type="checkbox"/>	Basis of the opinion	II	<input type="checkbox"/>	Priority	III	<input checked="" type="checkbox"/>	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability	IV	<input type="checkbox"/>	Lack of unity of invention	V	<input checked="" type="checkbox"/>	Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement	VI	<input type="checkbox"/>	Certain documents cited	VII	<input type="checkbox"/>	Certain defects in the international application	VIII	<input type="checkbox"/>	Certain observations on the international application
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Date of submission of the demand  <b>27.11.2003</b>	Date of completion of this report  <b>06.07.2004</b>																									
Name and mailing address of the international preliminary examining authority:   <b>European Patent Office - Gitschiner Str. 103 D-10958 Berlin Tel. +49 30 25901 - 0 Fax: +49 30 25901 - 840</b>	Authorized Officer  <b>Rufet, J</b>  Telephone No. +49 30 25901-332  																									

**INTERNATIONAL PRELIMINARY  
EXAMINATION REPORT**

International application No. **PCT/US 03/13371**

**I. Basis of the report**

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17):*

**Description, Pages**

1-138 as originally filed

**Claims, Numbers**

1-10 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).  
☐ the language of publication of the international application (under Rule 48.3(b)).  
☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.  
☐ filed together with the international application in computer readable form.  
☐ furnished subsequently to this Authority in written form.  
☐ furnished subsequently to this Authority in computer readable form.  
☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.  
☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:  
☐ the claims, Nos.:  
☐ the drawings, sheets:

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

*(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)*

6. Additional observations, if necessary:

**INTERNATIONAL PRELIMINARY  
EXAMINATION REPORT**

International application No. PCT/US 03/13371

**III. Non-establishment of opinion with regard to novelty, inventive step and industrial applicability**

1. The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), or to be industrially applicable have not been examined in respect of:

☐ the entire international application,

☒ claims Nos. 1-10 all partially

because:

☐ the said international application, or the said claims Nos. relate to the following subject matter which does not require an international preliminary examination (specify):

☐ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. are so unclear that no meaningful opinion could be formed (*specify*):

☒ the claims, or said claims Nos. 1-10 all partially are so inadequately supported by the description that no meaningful opinion could be formed.

☒ no international search report has been established for the said claims Nos. 1-10 all partially

2. A meaningful international preliminary examination cannot be carried out due to the failure of the nucleotide and/or amino acid sequence listing to comply with the standard provided for in Annex C of the Administrative Instructions:

☐ the written form has not been furnished or does not comply with the Standard.

☐ the computer readable form has not been furnished or does not comply with the Standard.

**V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

1. Statement

Novelty (N)	Yes: Claims	6-10
	No: Claims	1-5
Inventive step (IS)	Yes: Claims	
	No: Claims	1-10
Industrial applicability (IA)	Yes: Claims	1-10
	No: Claims	

2. Citations and explanations

**see separate sheet**

**Re Item III**

**Non-establishment of opinion with regard to novelty, inventive step and industrial applicability**

Present claims 1-10 relate to an extremely large number of possible compounds, compositions and uses thereof. Support within the meaning of Article 6 PCT and/or disclosure within the meaning of Article 5 PCT is to be found, however, for only a very small proportion of the compounds claimed. In the present case, the claims so lack support, and the application so lacks disclosure, that a meaningful examination over the whole of the scope is impossible.

The international search report has not been established for the part of claims 1-10 which appear not to be supported and disclosed.

Consequently, the examination has only been carried out for those parts of claims which appear to be supported and disclosed (Art. 34(4)(a)(ii) PCT) and which have been searched (Rule 66.1(e) PCT), namely those parts relating to the compounds of formula (I) of claim 1 with the following limitations:

- R1 is H, SH, Methyl and C2-C5 alkoxy carbonyl;
- R2, R3 are independently H, C1-C10 alkyl, C2-C10 alkenyl, C2-C10 alkynyl, cyclopropyl or R2 and R3 taken together are -CH<sub>2</sub>CH<sub>2</sub>nCH<sub>2</sub>- wherein n is 0 to 5;
- R4 to R10, R12 according to their respective definitions given in claim 1; R11 according to claim 2.

It is stressed that expressions like "carbocycle", "membered heterocycle", "optionally substituted", "heterocyclic ring containing 3 to 7 atoms....and optionally one or two additional atoms" etc.. present in the claims are speculative, embracing a great variety of structural possibilities not yet explored by the Applicant, the effect of which cannot be foreseen having regard to the problem to be solved.

**Re Item V**

**Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

Reference is made to the following documents:

- D1: US-A-5177106
- D2: WO-A-0006555
- D3: US-A-3284289
- D4: DE-A-2029298

**INTERNATIONAL PRELIMINARY  
EXAMINATION REPORT - SEPARATE SHEET**

International application No. PCT/US 03/13371

D5: DE-A-2113978  
D6: DE-A-2259221  
D7: WO-A-0046184  
D8: DE-A-2755549

1. The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claims 1-5 is in view of D1, D2 and D4 not new in the sense of Article 33(2) PCT.

Documents D1, D2 and D4 disclose a family of compounds using also a Markush formula, which overlaps with the family of compounds claimed (see D1, column 2, l. 36-52; column 8, l. 45-65; D2, page 6, example 4, claims 1, 7 and D4, p. 4, l. 32-34 and claims 1, 2).

It is pointed out that the subject-matter of claims 6-10 refer to compounds and compositions thereof, which appears to be novel over the prior art D1-D8.

2. The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claims 6-10 (which appears to be novel) does not involve an inventive step in the sense of Article 33(3) PCT for the following reasons:

The skilled person already knows from D3-D8 that amidinylphenyl compounds are useful for combatting pests, especially for combatting undesired plant growth, harmful micro-organisms (**fungi**), insects, acarids and nematodes (see D3, column 2, l. 8-20; D4, p. 45-46; D5, p. 6, l. 11, claims 3, 4; D6, p. 5, l. 3-8; D7, claims 1, 16 and D8, p. 6, l. 3-35, examples 2-7).

The skilled person looking for **further** amidinylphenyl compounds useful as **fungicide** would have, with expectation of success, considered the claimed compounds as possible alternatives to the compounds of D3 to D8, since he knows from D3 and D8 that structurally very close amindinylphenyl compounds are not only useful for combatting undesired plant growth, insects, acarids and nematodes but also for combatting fungi.